



IN THE UNITED STATES PATENT TRADEMARK OFFICE

In re application of: Luciano

Serial number: 09/527,705

5 Filed: March/17/2000

Title: MULTIPLE GAME APPARATUS AND METHOD

Attorney docket number: 732.083

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10 Group Number: 3713

Examiner: Marks

**DECLARATION OF LOREN NELSON
UNDER 37 C.F.R. § 1.132**

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Assistant Commissioner for Patents

Washington, D.C. 20231

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Dear Assistant Commissioner for Patents:

I, Loren Nelson, the undersigned, hereby submit this Declaration upon personal knowledge in connection with this, the above-identified, patent application by Robert Luciano ("the Luciano patent application").

1. I presently reside at 4650 Edmonton Drive, Reno, NV 89511.
- 25 2. I am employed by the owner of the Luciano patent application, Sierra Design Group, Inc., as its Director of Game Development. I have been employed in this capacity since February 2000.
3. I earned a BS degree in Electrical Engineering from the University of Nevada at Reno in 1991.
- 30 4. Before being employed by Sierra Design Group, I worked at International Game Technology (IGT) of Reno, NV for 8 years in game development, and worked as an independent consultant for gaming companies for a year.

5. I have reviewed the Luciano patent application, the Office Action mailed in this case February 20, 2003, and the British Stanley reference cited in that Office Action.

6. I believe that I am an expert in the field of gaming technology in general and in particular in the field of the type of gaming technology disclosed in the this patent application.

5 7. The above-identified Office Action states the following:

10 Stanley *teaches* an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the second game will lead to a further game on the first game (Abstract). In the disclosed apparatus, the second game of chance can lead to an alteration of the result of the first game of chance (page 5, lines 21-23) by obtaining a predetermined alteration outcome as a result of the game, such as rotating the reels (FIG 4, reference 10, NUDGES) and changing the first game outcome in the first game outcome display and providing a chance-improving outcome as the reels can then be moved to a winning combination. . . . Though Stanley
15 *does not distinctly disclose* that upon the first game of chance being played again, the second game of chance is again activated, *this is strongly implied* by Stanley in that the bonus game allows the play of the first game to again occur *and thus it would be inherent that the same payable is used in the first game*. Therefore, if the 'nudges' or
20 "spin until a win" are obtained from the bonus game in order to replay the first game result in a predetermined completion associated with the bonus game, the bonus game would axiomatically be re-enacted.

Office Action at 4 (emphasis added). This Office Action reiterated this view of the Stanley reference at 8.

25 8. In my opinion, the Stanley reference does not teach an ordinary artisan how to make and use "an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the game will lead to a further game on the first game (Abstract)." Although the Stanley reference does recite this objective or high level concept for a gaming machine of the type for which Stanley was apparently seeking patent protection, the Stanley reference is extremely cursory and does not teach much if any of the
30 mechanical, electrical, electronic, or programming details for the desired gaming machine. The

Stanley reference as a whole includes only four figures of limited external views of what the conceived game might look like, and its "specification" of how to make the conceived game is consists of only 3 pages of double and triple spaced text; and the entire pertinent Stanley disclosure is two small lines in the Abstract, three lines in the cursory Stanley specification, and 5 four Figures showing associated but very limited high level physical structure on the outside of a purported machine.

9. If one skilled in the art were to seek to build a gaming machine of the type recited in Stanley's Abstract, the ordinary artisan would need to develop and engineer virtually every aspect of the desired gaming machine: all of its electrical, electronic, and programming 10 structures and details, and virtually all mechanical structures and details, from scratch. I estimate the amount of time required for ordinary artisans to build a gaming machine of the type disclosed in Stanley, and recited by the Examiner in the Stanley Abstract cited by the Office Action, would require at least 1.5 man years of engineering and development effort.

10. The Stanley reference therefore does not really "teach" an ordinary artisan how to make 15 the desired gaming machine without undue effort. The Stanley reference really only discloses a high level concept for a gaming machine and how to use it, without disclosing any information, other than the high level concept, required by the ordinary artisan to make and use the desired gaming machine (i.e., one that would perform as recited in the Abstract of the Stanley reference).

11. In my view, the desired machine of the Stanley reference does not impliedly, necessarily, 20 or inherently include a payable in the first game that would re-initiate the second game as stated above in the Office Action. As the Office Action noted, the Stanley reference is silent about any such detail (or any other such "make and use" details as explained in paragraphs 8 and 9 above).

In fact, the Stanley reference does not even mention the term "paytable" or any equivalent term. Based on the express disclosure of the Stanley reference, the ordinary artisan would only understand that the first game could be re-initiated by the second game, but not that the second game could also be re-initiated by the re-initiated first game. According to the disclosure of the 5 Stanley reference, which does not mention, suggest, or imply any re-initiation of the second game by the re-initiated first game, I understand that the paytable for the desired Stanley gaming machine should be and most likely would be structured to allow for re-initiation of the first game by the second game but without providing, in turn, any re-initiation of the second game by the re-initiated first game.

10 12. In addition, it also my view that the Stanley reference does not teach that the first game would impliedly or necessarily use the same paytable for the first game upon its re-initiation based upon the outcome in the second game. In reality, the Stanley reference discloses very little about the paytable(s) to be included in the desired Stanley gaming machine, and the Stanley reference does not either imply or necessarily require that the re-initiated first game use the same 15 paytable as used in the original initiation of the first game (prior to the outcome of the first game causing the initiation of the second game).

13. It is therefore my opinion that the Stanley reference does not disclose a gaming machine in which the first game impliedly or necessarily includes either (i) one paytable that governs both the original and re-initiated operation of the first game; or (ii) one such paytable that itself also 20 impliedly or necessarily provides for possible re-initiation of the second game upon re-initiation of the first game.

14. I state under penalty of perjury that the foregoing is true and correct.

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Executed in Reno, Nevada, on this 19th day of May, 2003.

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Loren Nelson

Subscribed and sworn to before me by Loren Nelson, personally known to me, this 19th day of May, 2003.

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Carla Bankhead
Notary Public

